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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,093	10/15/2001	Yoshiyuki Endo	35.C15868	9339

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NEW YORK, NY 10112

EXAMINER

MOE, AUNG SOE

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/976,093	ENDO, YOSHIYUKI	
	Examiner	Art Unit	
	Aung S. Moe	2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 and 9 is/are allowed.
- 6) ☒ Claim(s) 1,3-6,10 and 11 is/are rejected.
- 7) ☒ Claim(s) 2 and 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited **to a single paragraph** on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because the Abstract should be a single paragraph. Correction is required. See MPEP § 608.01(b).

3. The disclosure is objected to because of the following informalities: In page 22, line 12, the word "trip" should be changed to - - "Travel" - - (i.e., noted that Fig. 12 shows "Travel", not "Trip").

Appropriate correction is required.

Drawings

4. Figure 18 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The

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replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 10-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites the limitation "said communication unit" in lines 9-10. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hull et al. (U.S. 5,806,005).

Regarding claim 1, Hull '005 discloses an external storage device (i.e., Fig. 1, the element 14) which is connected to an image pickup apparatus (12) provided with a first image storage medium (24) capable of storing plural taken images and image display means (i.e., the element 20; see col. 4, lines 45+) and adapted for backup of image information (i.e., noted that image stored in the camera 12 are backup in the server memory 58) stored in said first image storage medium (24), the device comprising:

a second image storage medium (58) capable of storing plural image information; a connection detecting unit (i.e., noted the elements 22, 26, 28, 52 and 56 of Fig. 1) for detecting the connection with said image pickup apparatus (12);

a reception unit for accepting a backup instruction for the taken image by a user (i.e., noted that the command instruction information can be inputted at the command input 32, and such instruction are received at the control unit 22 of the camera and the control unit 52 of the server 14; col. 2, lines 5+ and col. 4, lines 15+); and

transfer means (i.e., noted the elements 22, 26, 28, 52 and 56 of Fig. 1) for writing predetermined taken image information read from said first image storage medium (24) into said second image storage medium (58) (i.e., see col. 3, lines 1+) and erasing said predetermined taken image information (i.e., as discussed in col. 2, lines 60 thru col. 3, lines 35, the image stored in the memory 24 of the camera 12 can be erased after the images are transferred to the

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server 14 in order to freeing up the memory space at the memory 24 of the camera unit 12, thereby allowing to take as many picture as desired without worrying about running out of the memory space) from said first image storage medium (24) according to a detection output of said connection detecting means and an output of said reception means (i.e., noted the elements 22, 26, 28, 52 and 56 of Fig. 1).

Regarding claim 3, Hull 005 discloses wherein said reception unit accepts an operation for an operation unit of said image pickup apparatus (i.e., see col. 2, lines 5+ and col. 3, lines 5+ and col. 4, lines 15+).

Regarding claim 5, Hull '005 discloses wherein said image pickup apparatus includes means for operating a file in said second image storage medium (i.e., noted that the CPU 52 is capable of operating a image file received form the camera unit 12) and said external storage device executes an operation on the image file recorded in said second storage medium according to said file operation (i.e., the camera transmits the image files containing a specific command instruction information, such as e-mail address, encryption data and other protocols, to the server 14, and the server 14 executes an operation on the image file received based on the specific command instruction information; see col. 2, lines 5+, col. 3, lines 10+ and col. 4, lines 15+).

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9. Claim 6 is rejected under 35 U.S.C. 102(e) as being anticipated by Tsubaki (U.S. 6,701,058).

Regarding claim 6, Tsubaki '058 discloses a control method for an external storage device (20) connected to an image pickup apparatus (10) provided with a first image storage medium (13) capable of storing plural taken images and image display means capable of displaying (i.e., noted the display unit 17 of the camera 10 as shown in Fig. 1) at least said taken image and adapted for backup of the image information (i.e., noted the backup storage unit 28 of the external storage device 20), stored in said image storage medium (13), in a second image storage medium (28), the method comprising:

a connection detecting step of detecting the connection with said image pickup apparatus (i.e., noted that the communication parts 14 and 22 is capable of performing a connection detecting step);

an operation step of accepting an operation of the user (i.e., noted that the controller 12 and 26 is capable of accepting an operation step of the user; see Figs. 3-5); and

a first transfer step of writing predetermined taken image information read from said first image storage medium into said second image storage medium (i.e., noted the image transfer steps as shown in Fig. 3; col. 7, lines 65 – col. 8, lines 10+) and

erasing said predetermined taken image information from said first image storage medium according to the detection of connection in said connection detecting step and the acceptance of an operation in said operation step (i.e., col. 8. lines 5-60).

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10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hull et al. (U.S. 5,806,005).

Regarding claim 4, it is noted that Hull '005 does not explicitly show charging means for charging a battery of said image pickup apparatus. However, it is clearly well known that the camera device normally contains a rechargeable battery (i.e., see the conventional camera as shown in Fig. 18 of Applicant's disclosure having a rechargeable battery 238). In view of this, the Examiner takes an "Official Notice" it would have been obvious to one having ordinary skill in the art at the time of the invention was made to provide a charging means for recharging a camera's chargeable battery for the purpose of enhancing the power level at the camera side, thereby improving operability of the system as whole.

Allowable Subject Matter

12. Claims 2 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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13. Claims 10-11 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

14. Claims 8-9 are allowable over the prior art of record.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Safai '003 show a camera capable of transferring the images to the remote storage device.

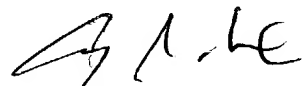
b. **Berstis '001 and Saito '365 shown an external storage device having charging means for charging a battery of the camera.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aung S. Moe whose telephone number is 703-306-3021. The examiner can normally be reached on Mon-Fri (9-5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on 703-305-4929. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Aung S. Moe
Primary Examiner
Art Unit 2612

A. Moe
September 30, 2004